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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,439	05/04/2001	Hiroyoshi Tsuchiya	205822US0CONT	8695

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EXAMINER

GUARRIELLO, JOHN J

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 03/25/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

69/848439

Applicant(s)

Tsuchiya et al.

Examiner

John Guarnello

Group Art Unit

1777

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-51 is/are pending in the application.
- Of the above claim(s) 24-31 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-23, 32-51 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_.

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3, 5
- ☒ Notice of Reference(s) Cited, PTO-892 ✓
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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## **DETAILED ACTION**

### ***Election/Restriction***

15. Restriction to one of the following inventions is required under 35

U.S.C. 121:

- I. Claims 1-23, 32-51, drawn to water absorbing composite, classified in class 442, subclass 417.
- II. Claims 24-31, drawn to method of making water absorbing composite, classified in class 427, subclass 180.

16. The inventions are distinct, each from the other because:

17. Inventions I and II are related as process of making and product made.

The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process, such as that disclosed by Young, Sr. et al., 5,230,959.

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18. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

19. During a telephone conversation with Vincent Shier on 9/13, 18/2002 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-23, 32-51. Affirmation of this election must be made by applicant in replying to this Office action. Claims 24-31, Group II are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

20. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

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amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 112***

21. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

22. Claims 1, 32, 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 32, it is the Examiner's position that the properties stated in the claim are not clear except for the diameter of the primary particles which is clear. It appears that the claim is directed to a composite with particles immobilized on a fibrous substrate with the stated properties.

In claim 45, line 2, it is not clear what the correct unit of diameter is, it appears to be the same as claim 36, please correct.

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***Claim Rejections - 35 USC § 102***

23. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-23, 32, 34-51 are rejected under 35 U.S.C. 102(b) as being anticipated by Masaki et al. 5,821,179.

Masaki describes an absorbent sheet for use in sanitary napkins, disposable diapers, kitchen paper towel, and other similar articles, (column 1, lines 6-11), which corresponds to the claimed water absorptive composite comprising a fibrous substrate with water absorbing polymer particles with average particle diameter of 1.0 to 1000 microns, (column 12, lines 52-60), which encompasses the average particle diameter of the claimed invention.

Masaki describes the amount of the polymer particles is at least 50% by weight or 70% by weight or more, (column 12, lines 1-5), which encompasses

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the claimed invention. Masaki describes the polymer particles in an amount of 5-300 g/square meter of the substrate, which encompasses the instant claims, (column 12, lines 40-42). Masaki describes the fibers for the substrate can be hydrophilic and can be natural or synthetic which encompass the claimed invention, (column 7, lines 64-67; column 8, lines 1-15). Masaki describes the agglomerate of polymer particles, (column 12, lines 6-11). Masaki describes various shapes the agglomerate can have, (column 12, lines 55-58). Masaki describes the absorbent sheet can be nonwoven cloth, (column 35, lines 1-4). Masaki describes fluff pulp, (column 34, lines 59-64). Since the claimed components, chemistry and structure, are encompassed by Masaki, the remaining properties, claims 13-18, would be inherent. It is the Examiner's position that Masaki describes the essential limitations of the claimed invention. Claims lack novelty.

***Claim Rejections - 35 USC § 103***

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. Claims 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Masaki et al. 5,821,179 in view of Tsuchiya et al. 5,962,068.

Masaki as above in paragraph # 24 but differs since it is silent about the steps in the product by process claim.

Tsuchiya describes various conditions, steps so that the degree of polymerization when droplets reach the substrate, (column 7, lines 63-67).

Tsuchiya describes some aspect of agglomerate even though difficult that can be accomplished, (column 1, lines 47-50).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use steps of Tsuchiya for agglomerate production in the absorbent article production of Masaki motivated with the expectation that the absorbent article would still improve absorption of liquids even though somewhat difficult.



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26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Guarriello whose telephone number is 703-308-3209. The examiner can normally be reached on Monday to Friday from 8 am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for the organization where this application or proceeding is assigned is 703-305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



John J. Guarriello:gj

Patent Examiner

March 12, 2003

March 19, 2003



TERREL MORRIS  
SUPERVISORY PATENT EXAMINER  
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